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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,888	09/05/2003	Roger S. Hutchison	501141.20506	7192
7590	04/11/2005		EXAMINER	
William H. Dippert Reed Smith LLP 29th Floor 599 Lexington Avenue New York, NY 10022-7650			THOMAS, DAVID B	
			ART UNIT	PAPER NUMBER
			3723	
			DATE MAILED: 04/11/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/655,888	HUTCHISON ET AL.
	Examiner David B. Thomas	Art Unit 3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 January 2005.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,5,7,10,11,15,17 and 20-26 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 21 and 22 is/are allowed.  
 6) Claim(s) 1,7,10,11,15,17,20 and 23-26 is/are rejected.  
 7) Claim(s) 5 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 9/5/03, 4/5/04, and 4/21/04 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1, 7, 11, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Okuda et al. (JP 06048082 A).

According to the English translation of the abstract, Okuda et al. disclose that at least a part of the magnetic layer 2 of a magnetic recording card 1 is destroyed or removed by a laser device. For example, a plurality of grooves 3 is formed on the magnetic layer 2 of the magnetic recording card 1 by the laser device. As a result, a treating method for disenabling regeneration of the magnetic recording card is obtained wherein many small cutting pieces and many punching pieces are not generated. The examiner notes the following: although the disclosure of Okuda et al. is directed to a method, there must also, necessarily, be some sort of apparatus associated with the method in order to perform the method; regarding the issue of “thermal energy” in

claims 7 and 17, the examiner respectfully contends that a laser is a form of thermal energy, therefore, the laser of Okuda et al. anticipates the “thermal energy” limitation.

3. Claims 1, 7, 10, 23, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Constantinou et al. (US 2003/0174616 A1).

Constantinou et al. disclose a compact disc that incorporates a security device for preventing non-authorized reading of the data carried by the disc. Constantinou et al. anticipate the method of destroying or disabling the device by focusing laser energy (also inherently “thermal energy”) at a point to cause the first and second layers to separate from each other (see pp. [0031-0034]).

4. Claims 1, 7, 10, 11, 15, 17, 20, and 24-26 are rejected under 35 U.S.C. 102(a) as being anticipated by Feehan et al. (US 2004/0125722 A1).

Feehan et al. disclose both a method and an apparatus for destructing an optical disc, including but not limited to DVD's, the method and apparatus either utilize laser energy focused at a point or thermal energy to cause separation, or destruction of the layers (see paragraph [0059]), and the information or storage device can be rotated on the apparatus.

#### ***Allowable Subject Matter***

5. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 21 and 22 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: Regarding the method claim 5, where the device is rotated as the laser energy is applied, it is the examiner's opinion that such has neither been anticipated nor fairly suggested, in part or whole, by the prior art of record. Also, regarding the additional step of treating one or both of the first and second layers in claim 21, it is the examiner's opinion that such has neither been anticipated nor fairly suggested, in part or whole, by the prior art of record.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 5, 7, 10, 11, 15, 17, and 20-26 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David B. Thomas whose telephone number is (571) 272-4497. The examiner can normally be reached on 7-4 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David B. Thomas  
Primary Examiner  
Art Unit 3723

  
dbt